

### **Remarks**

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated September 30, 2005, indicated that claims 17 and 19-22 stand rejected under 35 U.S.C. § 103(a) over Arnold *et al.* (U.S. Patent No. 6,016,504) in view of Dial (U.S. Patent No. 5,537,211) and claim 18 stands rejected under 35 U.S.C. § 103(a) in view of Arnold and Dial and in further view of Rose (U.S. Patent No. 5,930,769).

Applicant respectfully traverses each of the Section 103(a) rejections because the proposed combination of references is illogical as the cited references are incompatible. The '504 reference is directed to a virtual shopping experience using the internet whereas the '211 reference is directed to physical retail environment where objects are available for color measurement. The cited references teach away from each other, and the Office Action fails to present evidence of motivation to combine the references. Moreover, the hypothetical embodiment composed of the combined references would undermine the purpose of the primary '504 reference rendering the proposed combination improper. Further, the resulting hypothetical embodiment would fail to correspond to the claimed invention.

The proposed combination of references is improper and illogical because the cited teachings teach away from each other and from the claimed invention. A *prima facie* case of obviousness can be rebutted if the applicant can show "that the art in any material respect taught away" from the claimed invention. *In re Geisler*, 116 F.3d 1465, 1469, 43 USPQ2d 1362, 1365 (Fed. Cir. 1997) (quoting *In re Malagari*, 499 F.2d 1297, 1303, 182 USPQ 549, 553 (CCPA 1974)). Since the primary '504 reference is directed to a virtual shopping experience using the internet (as asserted against the claimed invention), the '504 system does not have access to any of the merchandise available over its system. In contrast, the '211 system requires that at least one article be physically available for color measurement with a photosensor head as explained at column 6, lines 28-30, *e.g.*, pressing the color sensor head against a person's skin. Thus the teachings diverge, at least, in the material respect of the '211 feature requiring actual access to colored articles that are not available to

the virtual system of the '504 reference. The cited references are incompatible as the '504 reference teaches away from any physical contact with merchandise.

The Office Action also fails to present any evidence of motivation to combine the cited references. As asserted, the skilled artisan would not be led by the cited art (or any other reason) to combine these teachings. The Office Action relies on the assertion that the '211 color matching scheme would provide a smallest difference between the colors of two apparel articles. However, this would only occur when there are various articles (that vary in color) to compare to an article. Without other values for comparison, a user would not be able to determine "the smallest difference" and would not be able to determine if the difference between two selected articles is acceptable. Without a presentation of evidence that the skilled artisan would combine the cited references as asserted and/or without a logical way to implement the combined teachings, the Section 103(a) rejections are improper and Applicant requests that they be withdrawn.

The proposed modification is also improper because it would frustrate the purpose of the '504 teachings thereby rendering the proposed modification unmotivated and improper. The MPEP states that when a proposed modification renders the teachings being modified unsatisfactory for their intended purpose, there is no suggestion or motivation to make the proposed modification under 35 U.S.C. § 103(a). *See* MPEP § 2143.01. As discussed above, the '504 reference is directed to providing a "virtual outlet." The Office Action appear to propose modifying the '504 reference by providing the '504 computer access to actual objects in order to be measured for a color frequency by the '211 photosensor means. This modification which is necessary for the comparison taught by the '211 reference would directly undermine the virtual nature of the '504 system. The skilled artisan would not be led to combine the cited references as asserted and Applicant submits that the proposed combination is improper.

The proposed combination of references further fails to correspond to the claimed invention because it would not include a computer-driven web-linking engine that is adapted to use a color matching criterion. The Office Action acknowledges that the '504 reference fails to teach using a color matching criterion to determine whether the first colored apparel article color matches the second colored apparel article color. As discussed above, the '211 teachings require actual access to the colored articles in order to measure the color frequencies with the photosensor. The '504 system does not have access to the

physical articles since it only obtains images of the articles; therefore, the '504 system cannot obtain or use the color measurements taught by the '211 reference. Moreover, if the '504 computer had the actual articles to measure the color frequencies with the '211 photosensor means, then there would be no correspondence because the '504 computer would not be a computer-driven web-linking engine that obtained the image of the articles from an on-line viewer site. Without a presentation of correspondence to each of the claimed limitations, the rejections are improper. Applicant accordingly requests that each of the rejections be withdrawn.

In view of the above discussion, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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